



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,571	04/17/2001	John Gordon Shulman	12497-1	6698
26486	7590	05/03/2006	EXAMINER	
PERKINS, SMITH & COHEN LLP ONE BEACON STREET 30TH FLOOR BOSTON, MA 02108			KESACK, DANIEL	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/836,571	SHULMAN ET AL.	
	Examiner	Art Unit	
	Dan Kesack	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 4/17/01.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/17/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This application has been reviewed. Original claims 1-27 are currently pending.
The rejections are as stated below.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. As claimed, claim 1 produces a plan, which is not considered a tangible result, as it may consist of nothing more than an abstract idea. Without a tangible result, the method is not useful, and is therefore unpatentable.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 3624

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 16-20, 22-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Thiessen, U.S. Patent No. 5,495,412.

Claims 16, 22, 25, 27, Thiessen discloses a system and method for computer assisted negotiations, comprising databases storing data about a plurality of stakeholders and issues in a transaction, and data including interests of each stakeholder, and storing data about possible actions to be taken in said transaction to satisfy said interests (figure 1, column 5 lines 37-47), further comprising a processor to provide an optimized course of action having a subset of said actions, determined based on the effects of said actions on the interests of the stakeholders (column 11 line 53 – column 12 line 17), and providing an interest chart showing the consequences of said actions with regard to said issues, and where the relationship between issue preferences can be inferred by the grouping of the interests on the chart with respect to the stakeholder (figures 3 and 5).

Claims 17-19, 23, 24, Thiessen teaches the transaction is a negotiation or mediation (column 3 lines 11-27) or a strategy planning session (column 6 lines 16-26).

Claim 20, Thiessen teaches receiving rating data rating each of the plurality of issues with respect to each of the plurality of stakeholders (column 7 lines 39-45);

Claim 26, Thiessen teaches determining whether the effects of a particular action are cumulative with the effects of another action (column 7 lines 9-28).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-15, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thiessen, U.S. Patent No. 5,495,412, in view of Wallman, U.S. Patent No. 6,338,047.

Claim 1, 21, Thiessen discloses a system and method for computer assisted negotiations, comprising:

receiving data about a plurality of stakeholders, a plurality of issues, and a plurality of interests in relation to a transaction (column 5 lines 37-47), the party representing a stakeholder, and the preferences representing interests;

creating links among said plurality of stakeholders and said plurality of issues and said plurality of interests, said links indicating relationships with regard to said transaction (figure 1), stakeholders, issues, and interests inherently linked when stored together in neutral computer (10);

receiving rating data rating each of the plurality of issues with respect to each of the plurality of stakeholders (column 7 lines 39-45);

receiving a plurality of actions related to said transaction, including data related to said interests (column 9 lines 13-39); and,

analyzing the actions according to a provided strategy to produce a plan having one or more of said actions affecting the strategy in the transaction (column 11 line 53 – column 12 line 17).

Claims 1, 21, Thiessen fails to teach receiving rating data rating each of said plurality of stakeholders in importance with respect to said transaction.

Claims 1, 21, Wallman teaches rating users of a financial negotiation concerning a mutual fund (stakeholders in the fund), based on how much money each user has contributed to the fund (importance with respect to the transaction). It would have been

Art Unit: 3624

obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the negotiation system and method of Thiessen to include rating users based on their importance to a given transaction because it is desirable to give those stakeholders who have a larger investment in the transaction different considerations than those who have a lesser investment.

Claim 2, 3, Thiessen teaches displaying the stakeholders, issues and interests in a chart, arranged according the interest data (figures 3 and 5).

Claims 4-6, Thiessen teaches stakeholders being a person, legal entity, or group of people (column 1 lines 14-25).

Claim 7, Thiessen teaches issues are components of a transaction (figure 2A).

Claim 8, Thiessen teaches interests are preferential outcomes of each party (column 3 lines 18-31).

Claims 9, 10, Thiessen teaches the transaction is a negotiation, or a strategy planning session (column 6 lines 16-26).

Claim 11, Thiessen teaches identifying a common base in the plurality of issues, and comparing the interests expressed in the common base to the preferences of the

stakeholders to determine the differences with respect to the common base (column 3 lines 29-50).

Claim 11, Thiessen teaches the common base is formed from the proposals and preferences submitted by the stakeholders. Thiessen fails to teach the common base being the proposal and preferences of a single "anchor" stakeholder. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to define an anchor stakeholder from among the stakeholders and use the proposal of that stakeholder as the common base, because doing so would reduce time needed for the negotiation process by selecting a single proposal as the starting off point for negotiations.

Claims 12, 14, Thiessen teaches determining whether a particular action is compatible with other actions, and determining whether a particular action overrides another action (figure 5 and columns 8-12)

Claim 13, Thiessen teaches determining whether the effects of a particular action are cumulative with the effects of another action (column 7 lines 9-28).

Claim 15, Thiessen teaches identifying one or more additional alternatives if said analyzing step does not produce a plan acceptable to the negotiating parties (column 12 line 54 – column 13 line 5).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



HANI M. KAZIMI
PRIMARY EXAMINER